

REMARKS/ ARGUMENTS

The foregoing amendment and the following arguments are provided to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

35 U.S.C. § 103(a) Rejections

Examiner rejected claims 1-6, 8-11m and 13-15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0030665 (hereinafter "Ano") in view of U.S. Patent No. 5,156,049 (hereinafter "Douglas").

NONANALOGOUS ART

In order to rely on a reference as a basis for rejection of an applicant's invention, the reference is to be in the field of applicant's endeavor. (MPEP 2141.01(a)).

In the current matter Douglas clearly is nonanalogous art to the subject matter claimed by applicant. In particular, applicant's claims are limited an input device on "a portable computer." Douglas, however, is directed to *automotive test equipment for balancing motor vehicle wheels* (Douglas, col. 1, lines 10-15.)

The subject matter of Douglas clearly would not have “commended itself to an inventor’s attention in considering” the problem resolved by applicant’s claimed invention. (*Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993.) Therefore, Douglas is not a reference to be relied upon to reject applicant’s claims as obvious.

NO REASONABLE EXPECTATION OF MODIFYING

Applicant further submits that it would not have been obvious to modify to Douglas to be implemented on a portable computer there would have been no reasonable expectation of successfully modifying Douglas at the time Douglas was invented. (See Manual of Patent Examining Procedure ¶ 2143.02; See also *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976), and *Ex parte Erlich*, 3 USPQ2d 1011 (Bd. Pat. App. & Inter. 1986)

In particular, as stated above, Douglas is intended to be implanted on a machine for automotive testing to determine wheel balance. Therefore, there would be no reasonable expectation of successfully modifying the disclosure of Douglas to be implemented on a portable computer.

Furthermore, the mere fact that a reference can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the modification or combination. *In re Mills*, 916 F.2d 80, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device “may be capable of being modified to run the way the apparatus is claim, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). (See also MPEP 2143.01).

In the present matter, Douglas is a nonanalogous art and is not capable of being modified to be implemented in a portable computer, and as such, there is clearly not suggestion or motivation in Douglas to do so.

Therefore, as stated above, Douglas is not a reference to be relied upon to reject applicant's claims as obvious. Furthermore, there is no reasonable expectation of successfully modifying Douglas. As a result, applicant's claims are patentable over Ano in view of Douglas.

CONCLUSION

Applicant respectfully submits the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call John Ward at (408) 720-8300, x237.

Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOLOLOFF, TAYLOR & ZAFMAN

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7/21/04



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